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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/973,837	10/11/2001	Kimitaka Murashita	1075.1175	7761

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STAAS & HALSEY LLP
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WASHINGTON, DC 20005

EXAMINER

PASIEWICZ, DANIEL M

ART UNIT	PAPER NUMBER
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2622

MAIL DATE	DELIVERY MODE
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12/27/2006

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/973,837

Applicant(s)

MURASHITA ET AL.

Examiner

Daniel M. Pasiewicz

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 01 December 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1, 14, 18, 22, 26 and 70-72.
Claim(s) withdrawn from consideration: 6, 30, 34, 38, 42, 46, 50, 54, 58 and 64.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____

Continuation of 3. NOTE: Amendment to independent claims 1, 70 and 71 change the scope of the claims and would require further search and/or consideration.



NGOC-YEN VU
SUPERVISORY PATENT EXAMINER

Response to Arguments

1. Applicant's arguments filed 12/1/2006 have been fully considered but they are not persuasive.
2. **The Examiner notes that the amendments to independent claims 1, 70 and 71 change the scope of the claims and require further search and/or consideration. Because of the amendment to independent claims 1, 70 and 71 the amendment will NOT be entered.**
3. With respect to **claim 72** Applicant argues, "claim 72 is very clear that the image dispensing apparatus reads images 'from an image data storing unit of an image forming apparatus' (see the claim preamble)" and "therefore, citing any elements inside of the digital camera in Okada as disclosing the features of claim 72 is inappropriate." Applicant then requests "withdrawal of the FINALITY of the Office Action because the Examiner did not meet the burden of proof for anticipation at least regarding claim 72."
4. The Examiner respectfully disagrees. While **claim 72** does claim "an image dispensing system capable to read images from an image data storing unit of an image forming apparatus", this does not limit the claimed components of the image dispensing system from not being part of the digital camera disclosed by **Okada**. **Okada** discloses an image dispensing system (as seen in Fig. 6 for example) that comprises several components. As the digital camera 10 is one of the components in the image dispensing system it is not inappropriate to cite elements inside the digital camera as disclosing features of the image dispensing system. Further, as stated in paragraph 18 of the Office Action mailed 9/1/2006 the Examiner has interpreted the image forming

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apparatus as the CCD 12 of the digital camera 10. As stated in paragraph 49 of **Okada** the storage unit of the image forming apparatus 12 is memory 18. **Okada** then discloses, in paragraph 62, the images are read from the memory 18 and transmitted to the image station apparatus 50 over the network 100. Thus, as the digital camera is part of the image dispensing system, the image dispensing system is capable of reading images from an image data storing unit (18) of an image forming apparatus (12).

Therefore, the Examiner has met the burden of proof for anticipation of **claim 72** and the FINALITY of the Office Action is proper and will not be withdrawn.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel M. Pasiewicz whose telephone number is (571)272-5516. The examiner can normally be reached on M-F 8:00AM to 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ngoc Yen Vu can be reached on (571)272-7320. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

DMP

December 19, 2006



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SUPERVISORY PATENT EXAMINER